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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,426	02/28/2002	Lauri Paatero	944-005.5	6252

4955 7590 01/09/2008

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ART UNIT	PAPER NUMBER
2132	

MAIL DATE	DELIVERY MODE
01/09/2008	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/090,426
Filing Date: February 28, 2002
Appellant(s): PAATERO, LAURI

Andrew T. Hyman
Reg. No. 45,858
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 October 2007 appealing from the Office action mailed 29 June 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,968,453	Doyle et al.	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-27, 35-43, and 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Doyle et al (US Patent #6,968,453).

With regards to claim 1, Doyle et al disclose a method, comprising:

embedding a role certificate in a device, wherein the role certificate identifies at least one permitted activity that at least one party is allowed to perform with respect to the device, and wherein the role certificate is generated by a certification authority; (note figure 1 and associated description; note column 9, line 54; note column 7, lines 13-17; note column 11, lines 8-40; note figures 4 & 6)

embedding at least information regarding a public key in said device the public key corresponding to the private key used by the certification authority to sign the role certificate; and (note figure 1 and associated description; note

column 9, line 54; note column 8, lines 1-30; note column 9, lines 46-67; note column 7, lines 13-17; note column 11, lines 8-40; note figures 4 & 6)

running the device so as to verify the role certificate using said information regarding the certification authority public key so that said at least one permitted activity can be activated within the device by said at least one party if the role certificate is verified, (note figure 1 and associated description; note column 5, lines 1-24; note column 6, lines 28-37; note column 11, lines 8-40; note figures 4 & 6)

wherein the at least one party communicates with the device to perform the permitted activity, only after the role certificate is embedded in said device, (note column 11, lines 8-40 – third party upgrading implies communication with the third party)

wherein the at least one party performs the at least one permitted activity by establishing a wireless connection to the device, and (note column 11, line 18)

wherein the role certificate also identifies the at least one party. (note column 11, line 18)

With regards to claims 20 and 49, Doyle et al disclose a role certificate mechanism, comprising:

memory containing a role certificate, wherein the role certificate is configured to identify at least one activity permitted to be activated within a

device in response to a communication from at least one party, and further wherein the memory contains information regarding a first key corresponding to a second key used to sign the role certificate; and (note figure one and associated description; note column 7, lines 13-17; note figures 4 & 6)

processor configured to run the device so as to verify the role certificate using said information regarding the first key so that said at least one permitted activity can be activated within the device, (note figure one and associated description; note column 5, lines 1-24; note figures 4 & 6)

wherein the role certificate mechanism is configured to receive the communication only after the role certificate is embedded in said mechanism (note column 11, lines 8-40 – third party upgrading implies communication with the third party)

wherein the at least one party performs the at least one permitted activity by establishing a wireless connection to the device, and (note column 11, line 18)

wherein the role certificate also identifies the at least one party. (note column 11, line 18)

With regards to claim 26, Doyle et al disclose an apparatus or system, comprising:

means for embedding a role certificate in a device, wherein the role certificate identifies at least one permitted activity that is allowed to be performed by at least one party with respect to the device, and wherein the role certificate is generated by a certification authority; (note figure 1 and associated description; note column 5, lines 3-5; note column 6, lines 46-54; note column 7, lines 13-17; note figures 4 & 6)

means for embedding information regarding a public key in said device, the public key corresponding to the private key used by the certification authority to sign the role certificate; and(note figure 1 and associated description; note column 5, lines 47-52; note column 9 , lines 46-67; note column 18, lines 66-67 and column 19, lines 1-34)

means for running the device so as to verify the role certificate using said information regarding the certification authority public key so that said at least one permitted activity can be activated within the device by said at least one party; (note figure 1 and associated description; note column 6, lines 28-37; notes column 7, lines 1-17; note figures 4 & 6)

wherein the at least one party communicates with the device to perform the permitted activity, only after the role certificate is embedded in said device (see arguments above; note column 11, lines 8-40 – third party upgrading implies communication with the third party and the device can be manufactured to include a generic role certificate)

wherein the at least one party performs the at least one permitted activity by establishing a wireless connection to the device, and (note column 11, line 18)

wherein the role certificate also identifies the at least one party. (note column 11, line 18)

With regards to claim 41, Doyle et al disclose a method comprising:

embedding a role certificate applicable to a plurality of devices in an individual device, wherein the role certificate specifies at least one permitted activity that is allowed to be performed by at least one party as applied to the plurality of devices, and wherein the role certificate is generated by a certification authority; (note figure 1 and associated description; note column 5, lines 1-5; note column 7, lines 13-17; note column 9, lines 46-67; note column 12)

embedding at least information regarding a public key applicable to the plurality of devices in said individual device, the public key corresponding to the private key used by the certification authority to sign the role certificate; and (note figure 1 and associated description; note column 5, lines 1-5; note column 7, lines 13-17; note column 9, lines 46-67; note column 12)

running the individual device so as to verify the role certificate using said information regarding the certification authority public key so that said at least one permitted activity can be activated within the individual device by said at least on party if the role certificate is verified, (note figure 1 and associated

description; note column 5, lines 1-5; note column 7, lines 133-17; note column 9, lines 46-67; note column 12; note column 6, lines 28-37)

wherein the at least one party communicates to perform the permitted activity, only after the role certificate is embedded in said individual device, (note column 11, lines 8-40 – third party upgrading implies communication with the third party)

wherein the at least one party performs the at least one permitted activity by establishing a wireless connection to the device, and (note column 11, line 18)

wherein the role certificate also identifies the at least one party. (note column 11, line 18)

(10) Response to Argument

Applicant first argued that Hind (US Patent #6,976,163) is not properly incorporated into the Doyle reference, and that this renders rejections based on the sentence found at column 11, line 18 of Doyle incorrect. The examiner respectfully disagrees, noting that Hind is, in fact, properly incorporated. MPEP Rule §1.57 (b) requires that

...an incorporation by reference must be set forth in the specification, and must:

(1) Express a clear intent to incorporate by reference by using the root words "incorporat(e)" and "reference" (e.g. "incorporate by reference"); and

(2) Clearly identify the referenced patent, application, or publication.

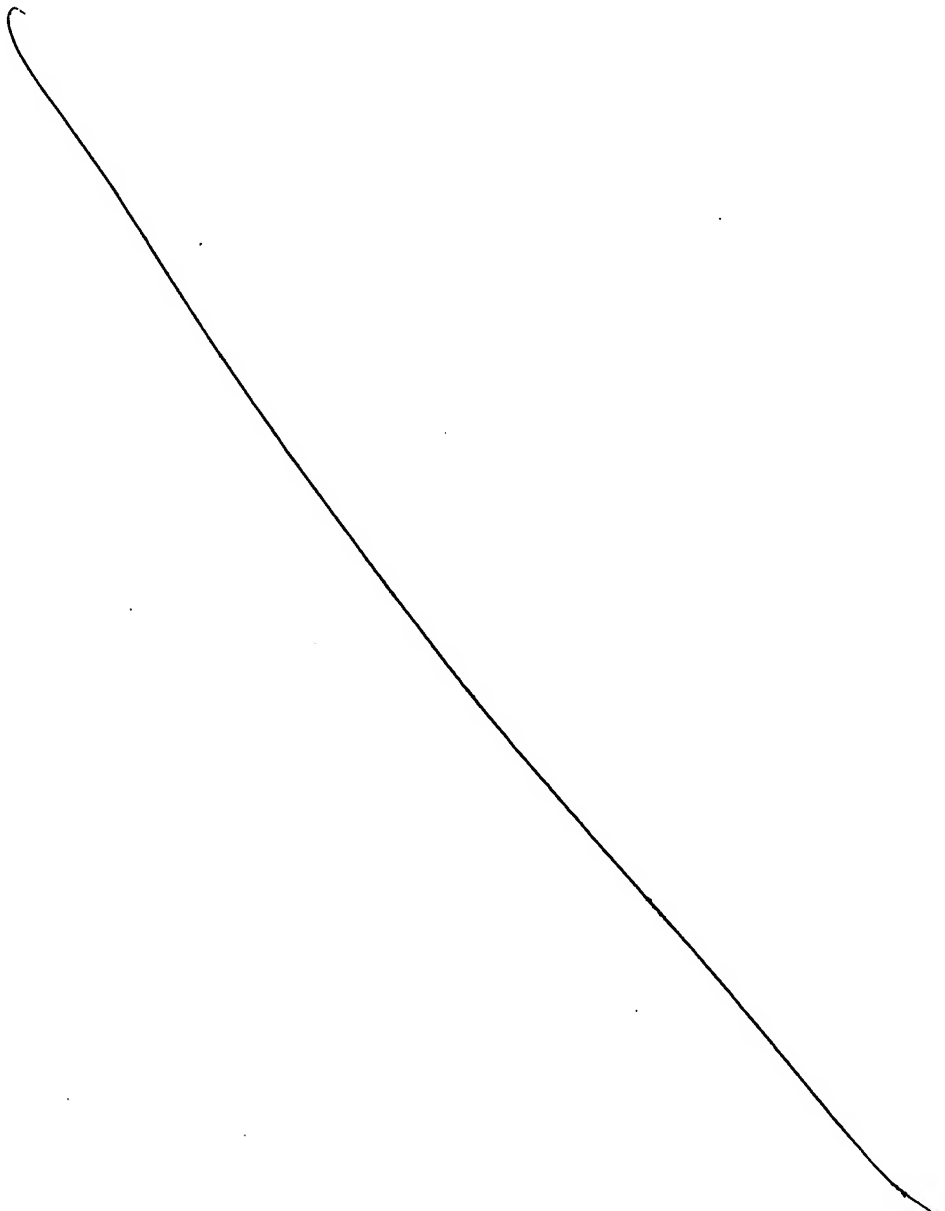
The incorporation by reference of Hind occurs in the specification of Doyle (specifically, at column 8, lines 1-15 in the Detailed Description), expresses a clear intent to incorporate by reference ("...the teachings of these patents are hereby incorporated by reference"), and clearly identifies the referenced patent, application, or publication (Hind is referenced both by application number 09/614,983 and by the title "Methods, Systems, and Computer Program Products for Rule Based Firmware Updates Utilizing Certificate Extensions").

Applicant's arguments regarding the incorporation of Hind were originally directed to now-cancelled claim 46. The text of claim 46 was inserted into the independent claims and is now the sole argument for patentability of all pending claims. However, as described above, Doyle's incorporation by reference of Hind complies with all USPTO requirements for incorporation by reference, both presently and at the time of filing.

Furthermore, page 3, lines 10-11 of Appellant's specification provide a definition for the role certificate that "the role certificate controls the acceptance of computer code for use in a specific mobile phone." This broad definition is met by the disclosure of Doyle at column 11, lines 18-40, and in particular, lines 35-40.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.



For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Virgil Herring

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